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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,334	11/18/1999	KARI VIRTANEN	PM264014	3837

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PILLSBURY WINTHROP, LLP
P.O. BOX 10500
MCLEAN, VA 22102

EXAMINER

IQBAL, KHAWAR

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/381,334

Applicant(s)

VIRTANEN, KARI

Examiner

Khawar Iqbal

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) 4-7 and 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.
3. The specification objected to because the specification sections are not properly formatted on the appropriate heading. Appropriate correction is required.

Claim Objections

4. Claims 4-7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent cannot depend from any other multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims 4-7 not been further treated on the merits.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1,2,7,10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The phrase "such as" and "preferably" found in the claims does not positively recite the claim subject matter

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 1-3, 8-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Salin et al (6370390).

Regarding claim 1 Salin et al teach a method of registration in a telecommunications system by a mobile station, which system comprises a home location register for maintaining subscriber data and supports a first network, GSM, and a second network, GPRS; the method comprising the steps of (abstract, fig. 1):

maintaining the mobile subscriber data in the home location register (HLR), and sending, from another network element, a message to the home location register for requesting the mobile subscriber data (col.7, lines 30-50);

characterized in that the home location register maintains an access parameter which indicates whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 5, lines 15-33, col. 7, lines 30-50);

in response to said message for requesting the subscriber data, the home location register sends the mobile subscriber data and also said access parameter (col.8, lines 11-29);

the network element that requested the mobile subscriber data uses said access parameter for restricting the access of the mobile subscriber only to the first network or to the second network (col.9, lines 20-44, col. 10, lines 30-54).

Regarding claim 2 Salin et al teach a method of registration in a telecommunications system by a mobile station, which system comprises home location register for maintaining subscriber data and supports a first network, GSM, and a second network, GPRS (abstract, fig. 1):

the method comprising storing mobile subscriber data in the memory of a mobile station, (preferably in its SIM card) (col. 7, lines 30-50);

characterized in that

an access parameter indicating whether the mobile subscriber is entitled to use the first network, the second network or both networks is also stored in the memory of the mobile station (col. 5, lines 15-33);

the mobile station uses said access parameter to restrict the access of the mobile subscriber only to the first and/or the second network (col.7, lines 3-24, col. 10, lines 30-55).

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Regarding claim 3 Salin et al teach the mobile subscriber's access can be restricted only to one network even though a short message service had been defined for the mobile subscriber (col. 7, lines 3-24,col. 8, lines 12-29, col. 10, lines 30-55).

Regarding claims 8,9 and 10 Salin et al teach a data structure which comprises mobile subscriber data in a telecommunications system which supports a first and a second network (abstract, fig. 1);

characterized in that the data structure also comprises an access parameter which indicates whether the mobile subscriber is entitled to use the first network, the second network or both networks (col. 7, lines 3-49, col. 10, lines 30-55).

Regarding claim 11 Salin et al teach first network is a circuit-switch and second is packet –switched (col. 2, lines 38-52, col. 17, lines 18-650).

8.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure Willars et al (# 5946630), Josse et al (6104929), Corriveau et al (6097962), Andersson (6047194) and Shannbon et al (# 6032044) teach apparatus and method use a mobile communications network as an access network, to a dual-mode mobile station in a communication system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHAWAR IQBAL whose telephone number is 703-306-3015.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **URBAN EDWARD F**, can be reached at 703-305-4385.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2684 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Khawar Iqbal



EDWARD F. URBAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600